



S. O. Riddle
4/29/03
PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Shinya HIROTA et al.

Application No.: 10/088,476

Filed: March 20, 2002

For: EXHAUST GAS PURIFICATION DEVICE

Group Art Unit: 3748

Examiner: T. Nguyen

Docket No.: 112340

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Election
w/atto.*

RESPONSE TO ELECTION OF SPECIES REQUIREMENT

RECEIVED

Director of the U.S. Patent and Trademark Office
Washington, D.C. 20231

APR 29 2003
TECHNOLOGY CENTER R3700

Sir:

In reply to the Election of Species Requirement mailed March 25, 2003, Applicants provisionally elect Species B, described on page 63, lines 5-10. Applicants submit that claims 4, 5 and 13 read on elected Species B. It is submitted at least claims 1, 2, 6-12 and 16-21 are generic to all species. This election is made with traverse.

Because this application is the National Stage of an International Application filed under 35 U.S.C. §371, any Restriction/Election of Species Requirement must comply with the provisions of 37 C.F.R. §1.499, and the Election of Species Requirement fails to comply with those provisions.

DISCUSSION

37 C.F.R. §1.499, which is discussed and explained in detail in MPEP §1893.03(d), points out that when making a lack of unity requirement, the Office Action must (1) list the different groups of claims and (2) explain why each group lacks unity with each other group

(i.e., why there is no general inventive concept) specifically describing the unique special technical feature in each group.

The Election of Species Requirement mailed March 25, 2003 failed to list the different groups of claims pending in this application and to explain why each group lacks unity with each other group, specifically describing the unique special feature in each group.

MPEP §1893.03(d) points out that a group of inventions is considered linked to form a single general inventive concept where there is a technical relationship among the inventions that involves at least one common or corresponding special technical feature. The expression "special technical feature" is defined as "those technical features that define the contribution which each claimed invention, considered as a whole makes over the prior art." See page 1800-19 of the MPEP. Thus, an Office Action must explain why whatever is identified as a common or corresponding special technical feature is explained in terms of how that feature defines over the prior art.

The Election of Species Requirement merely states that there are two patentably distinct species of the claimed invention, one of which is a bypass mechanism shown in Figures 22-25 and the other of which is controlling air flow into a combustion chamber described on page 63, lines 5-10. This explanation fails to comply with the explicit requirements of 37 C.F.R. §1.499 and MPEP §1893.03(d) because it (1) does not list the different groups of claims; (2) does not list the common or corresponding technical features of those groups of claims; (3) does not identify the prior art; (4) and does not demonstrate that any such common or corresponding technical feature is "special", i.e., defines over the prior art. Moreover, if, as here, there is only one independent claim, and this claim is determined to be patentable, the Office must determine whether there is still an inventive link between claims dependent on that independent claim. See, in this regard, MPEP Appendix AI, Annex B, Part UI, page AI-31.

These requirements, which are a prerequisite to making an election requirement complying with the unity of invention requirements, were not met in the March 25, 2003 Election of Species Requirement.

Moreover, because the Office Action does not follow its own Rules of Practice and Manual of Patent Examining Procedure (MPEP), Applicants have been denied both procedural and substantive due process as required in general under the Administrative Procedures Act. See in this regard, In re Zurko, 119 S.Ct. 1816, 50 USPQ2d 1930 (1999), and In re Gartside, 53 USPQ2d 1769 (Fed. Cir. 2000).

Thus, the election of species requirement is fundamentally improper and must be withdrawn because it fails to comply with the explicit requirements of the aforementioned Rules of Practice and failed to make out a prima facie case of lack of unity of invention, which is a prerequisite to a proper election of species requirement in a PCT National Stage application. Additionally, all claims should be examined on their merits because they all evidence unity of invention, including "commonly recited special technical features" for reasons stated in the Amendment After Final Rejection.

Furthermore, it has been the policy of the Office since the mid-1990s to place the burden of establishing a prima facie case of lack of unity of invention on the Examiner and, if the Examiner's holding of Lack of Unity of Invention does not make out a prima facie case of lack of unity of invention, then the requirement will be withdrawn and all claims be examined on their merits. This policy is reflected in the attached protest decision, which was rendered in the very same Examining Sector in which this Election of Species was rendered. The decision, which is sanitized, was rendered by then Group Director Donald G. Kelly in 1996. It is Applicants' contention that the holding of Lack of Unity of Invention did not make out a prima facie case of lack of unity of invention and because of this, did not accord Applicants procedural and substantive due process

Applicants also respectfully submit that PTO Election of Species Requirements for applications filed under 35 USC §111(a) do not override the requirements of MPEP §1893.03(d), including 37 CFR §1.499. To do this, a consideration of the history of PCT lack of unity of invention practice is in order.

In 1978, when the United States adopted the Patent Cooperation Treaty, it changed 37 CFR 1.141 to bring U.S. Restriction practice a little bit closer to Unity of Invention practice. 37 CFR 1.141(a) was changed to provide that while two or more independent and distinct inventions may not be claimed in one national application (filed under 35 USC 111), more than one species of an invention, not to exceed a reasonable number, may be specifically claimed in different claims in one national application, provided that the application also includes an allowable generic claim generic to all the claimed species, and all the claimed species in excess of one are written in dependent form (per 37 CFR 1.175) or otherwise include all the limitations of the generic claim. 37 CFR 1.146 was also changed to indicate that restriction practice concerning an application having a generic claim and claims directed to more than one species must permit applicant to claim a reasonable number of species, i.e., restriction is only proper if the application contains claims to more than a reasonable number of species.

That was the only change in restriction practice for applications filed under 35 USC 111. For example, Restriction/Election of Species requirements in U.S. domestic practice (in applications filed under 35 USC 111) were not changed. This was made clear in the O.G. Notice that was issued when the U.S. adopted the Patent Cooperation Treaty. See the treatment of Unity of Invention and implementation thereof in International Applications in the Official Gazette Notice of April 28, 1987 reprinted in the January 7, 1992 Consolidated Listing of O.G. Notices appearing at 1134 O.G. 196+, especially pp. 197-7 - which points out

the applicability of Genus-Species restriction practice to lack of Unity of Invention determinations in International Applications.

Further evidence of this is found in MPEP Appendix AI, Annex B, Part I, page AI-31, which sets forth guidance on PCT Rule 13 and its applicability to situations where a generic claim is not found allowable. In particular, it points out that:

If, however, an independent claim does not avoid the prior art, then the question whether there is still an inventive link between the claims dependent on that claim needs to be carefully considered. If there is no link remaining, an objection of lack of unity a posteriori (that is, arising only after assessment of prior art) may be raised. Similar considerations apply in the case of a genus species or combination/subcombination situation.

The Office was forced to change its restriction practice further, as a result of the Caterpillar case, for National stage applications filed under 35 USC 371(c). This change was codified in 37 CFR 1.475-477 in 1987. This change relates to situations where an applicant presents claims drawn to different statutory classes of invention.

The basis for lack of unity of invention determinations changed even further in applications filed under 35 USC 371(c) when, in May 1993, 37 CFR 1.475 was changed, based on a corresponding change in PCT Rule 13, in January 1993. That change to 37 CFR 1.475(a) made it clear that an international and a national stage application shall relate to one invention only, or to a group of inventions so linked as to form a single general inventive concept ("requirement of unity of invention"). The requirement of unity of invention is met when there is a technical relationship among those inventions involving one or more of the same or corresponding **special** technical features. The expression "**special** technical features" means those technical features which define a contribution which each of the claimed inventions, considered as a whole, makes over the **prior art**.

The amendments to 37 CFR 1.475(a) did change the ground rules with respect to claims directed to different statutory categories of invention, which are found in 37 CFR 1.475(b). This is reflected in 37 CFR 1.475(c) which notes that if an application contains claims to more or less than one of the combinations of categories of invention set forth in 37 CFR 1.475(b), unity of invention might not be present. In other words, an application may contain claims to a product and a process specially adapted for manufacturing that product but, if the product claims and the process claims do not contain any commonly recited **special** technical features, i.e., the only commonly recited technical features are unpatentable over prior art, the claimed inventions in that application lack unity of invention.

Thus, it is clear that there is a fundamental difference between U.S. restriction practice pertaining to applications filed under 37 CFR §111(a), which does not require a search of prior art, and applications filed under the PCT, which do require a search of prior art when there are commonly recited technical features among the claims, and the U.S. restriction practice guidelines do not override the explicit requirements of PCT Lack of Unity of Invention Practice.

Turning to the PCT Lack of Unity of Invention requirements, one must begin an evaluation of the unity of invention issue in terms of the independent claims. See PCT Administrative Instructions, Annex B, which are found in MPEP Section AI, pages AI 38-AI 53. Each independent claim in each different group must be evaluated to determine if those independent claims recite one or more common "special" technical features. A technical feature is "special" if it defines over the prior art. The holding of Lack of Unity of Invention in this application failed to address whether there are any commonly recited special technical features in the asserted groups, an issue which must be addressed to determine whether unity of invention exists among the asserted groups. The fact that one particular special technical feature is recited in one group but not in another group is not relevant to whether one or more other special technical features are commonly recited in both groups.

The holding of Lack of Unity of Invention in this application explicitly listed which claims corresponded with each species. Once that listing was made, it was incumbent on the Examiner to start with the one independent claim which is pending, i.e., claim 1 and to indicate which of the recited technical features of claim 1 were "special," i.e., patentable over the prior art. This is a fundamental difference between PCT Lack of Unity of Invention practice and U.S. restriction practice in applications filed under 37 CFR 1.111(a). This fundamental requirement of PCT Lack of Unity of Invention practice was not followed or adhered to by the Examiner in the holding of Lack of Unity of Invention.

The holding of Lack of Unity of Invention Practice in this application (in paper No. 3) fails to (1) identify the common technical features in claims 1 and 14, (2) demonstrate why any commonly recited technical features in those claims are unpatentable over the prior art, and (3) address lack of unity of invention with respect to all of the dependent claims. Accordingly, the holding of Lack of Unity of Invention did not follow the express mandates of 37 C.F.R. §1.499 as discussed and explained in detail in MPEP §1893.03(d) and Annex B of the PCT Administrative Instructions, and thereby failed to accord Applicants the procedural and substantive due process to which they are entitled.

A fair, balanced review of the Election of Species Requirement reveals that it failed to make out a prima facie case of Lack of Unity of Invention by failing to comply with PTO Rules of Practice and MPEP guidance which is consonant with, and not overridden by, U.S. restriction practice in applications filed under 35 USC §111(a), should be withdrawn, and all claims should be examined on their merits.

Moreover, it is respectfully submitted that the subject matter of all species is sufficiently related that a thorough search for the subject matter of the elected species would encompass a search for the subject matter of the remaining species. Thus, it is respectfully submitted that the search and examination of the entire application could be made without

serious burden. See MPEP §803 in which is stated that "If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions." (Emphasis added). It is respectfully submitted that this policy should apply in the present application to avoid unnecessary delay and expense to Applicants and duplicative examination by the U.S. Patent and Trademark Office.

Lastly, even if 35 USC §121 applied to this application, which it does not, election of species is not proper because there is only one independent claim, which links both alleged species. See MPEP §809.03.

In view of the foregoing, it is respectfully submitted that the Election of Species Requirement must be withdrawn and claims 1-21 examined on their merits.

Respectfully submitted,



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JAO:RJW/sxb

Enclosure:

Sanitized Decision on Protest of Holding of Lack of Unity

Date: April 25, 2003

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